



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/269,972	04/08/1999	YUKIO NAKAJIMA	Q53854	1844

7590 04/06/2007
SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 200373202

EXAMINER

CRAIG, DWIN M

ART UNIT	PAPER NUMBER
----------	--------------

2123

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/269,972

Applicant(s)

NAKAJIMA, YUKIO

Examiner

Dwin M. Craig

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/2006 has been entered.
2. Claims 1- 19 have been presented for examination based on Applicant's amended claim language and Request for Continued Examination (RCE) under 37 CFR 1.114.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8 and 9-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
 - 3.1 Claims 1-8 and 9-19 are directed towards a tire design method. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful concrete and tangible result.

Specifically the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for

Art Unit: 2123

designing a tire based upon a design parameter of the tire. This produced result remains in the abstract and, thus, fails to achieve the required status of having real world value. Further the current claim language fails to teach a conveyance from the abstract design of a tire into the real world.

The Examiner notes that the Applicant's specification provides support for a claim amendment that provides a concrete, useful and tangible result, see page 27 of Applicants' specification, "...displaying calculation results..."

3.2 Amendment is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 5,435,365 to Tanaka.
- 4.1 Regarding claims 1 and 9, claim 9 teaches, *a tire is formed according to design parameters designed by a tire design method according to claim 1.*

MPEP 2113 Product-by-Process Claims, "*Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself*" therefore any teaching of a tire that is formed by a process teaches Applicant's claimed tire, Tanaka teaches a tire that has been formed (Figure 1 and the descriptive text and Col. 1 lines 40-56).

Allowable Subject Matter

5. After consideration of Applicants' arguments presented on 10/30/2006 and after considering the dictionary definition of the word "*extreamum*" the current prior art rejections of the claims has been withdrawn. The dictionary definition of the term *extreamum* defines the term to mean, *a maximum or a minimum of a mathematical function* see page 413 of Merriam-Webster's Collegiate Dictionary. The only clear interpretation of the use of the phrase *plurality of extreamums*, as amended into Applicants' claim language, is disclosed in figure 9 and the descriptive text in Applicants' specification on page 2. The Examiner has found Applicants' arguments, in combination with the amendments to the instant claims, to be persuasive. More specifically, the deletion of the term "*non-linear*" in combination with the addition of the phrase "*plurality of extremums*" in combination with the remaining elements and features of the claimed invention have been sufficient to overcome the previously applied 35 U.S.C. 103(a) rejections of the instant claims.

5.1 The Examiner notes that on page 15 of the remarks Applicants' have stated that they have amended the specification, "*...the term "non-linear" appearing in the claims and the specification is hereby deleted and the expression "the plurality of extremums" is used instead...*" Applicants' claimed that they have amended the specification but no amendment to

Art Unit: 2123

the specification has been provided, the Examiner respectfully requests that the Applicants' point out what amendment to the specification is being proposed.

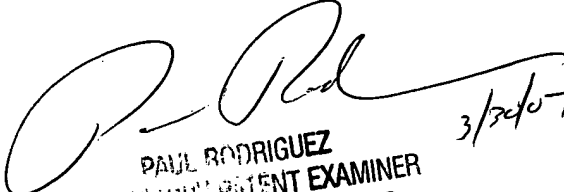
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwain M. Craig whose telephone number is (571) 272-3710. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul L. Rodriguez can be reached on (571) 272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dwain McTaggart Craig


PAUL RODRIGUEZ
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2100
3/26/07